

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HELMUT SCHWEGLER, BERNHARD LUCAS,
WOLFGANG BUESER and ULRICH PROJAHN

Appeal No. 1999-2126
Application No. 08/857,938¹

ON BRIEF

Before CALVERT, ABRAMS, and FRANKFORT, ***Administrative Patent Judges***.

ABRAMS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 19-21, 23 and 24. Claims 1-18 have

¹ Application for patent filed May 16, 1997.

been canceled, and claims 22 and 25-30 have been withdrawn from consideration as reading on non-elected species (Paper No. 6). No claims have been allowed.

The appellants' invention is directed to a liquid filter and pressure regulator. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Burhans et al. (Burhans) 8, 1966	3,233,738	Feb.
Wilkinson 18, 1968	3,388,802	Jun.
Robinson (Robinson '203) 4, 1994	5,275,203	Jan.
Robinson (Robinson '241) 18, 1995	5,433,241	Jul.
Gebert et al. (Gebert) 1997	5,698,097	Dec. 16,

(filed Sep. 13, 1995)

THE REJECTION²

² The rejection of claims 19-21, 23 and 24 under 35 U.S.C. § 112, second paragraph, that appeared in the final rejection (Paper No. 8) apparently was overcome by the amendment entered thereafter (Paper No. 11), for it was not repeated in the

Claims 19-21, 23 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Robinson '241 in view of Robinson '203 and Wilkinson, Gebert or Burhans.

OPINION

Rather than attempt to reiterate the details of the explanation of the rejection and the opposing viewpoints of the examiner and the appellants, we refer to the Examiner's Answer and the Brief.

The rejection before us is under 35 U.S.C. § 103. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this

Answer.

end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, **Uniroyal, Inc. v. Rudkin-Wiley Corp.**, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

The appellants' invention is directed to a liquid filter having a pressure regulator that permits liquid flow from the clean side of the filter to exit through a return line if the operating pressure of the regulator is exceeded. The examiner has rejected independent claim 19 on the basis of three alternative rejections, all of which employ the basic combination of Robinson '241 and Robinson '203. According to the examiner, Robinson '241 discloses all of the subject matter recited in claim 19 except for the particular pressure regulator recited and the double walled inlet tube. However, it is the examiner's position that one of ordinary skill in the art would have found it obvious to modify Robinson '241 first by replacing the disclosed pressure regulator with the one

disclosed in Robinson '203, and second by including a double-walled tube as disclosed in Wilkinson, Gebert or Burhans.

Robinson '241 discloses a liquid filter and pressure regulator in which, just as in the appellants' invention, liquid enters an inlet from a supply tank (the dirty side), flows through a filter into a central tube (the clean side), and then flows out to the point of use. The liquid that is flowing out of the device through the central tube (124) also impinges against a pressure regulator (44), the construction of which is not described. If the pressure in the central tube exceeds the operating value of the pressure regulator, liquid also can exit through a return port (66) to the supply tank. Robinson '203 discloses a pressure regulator comprising a diaphragm (18) that operates a valve element (24) which interacts with a valve seat (30). The diaphragm is exposed on one side to the pressure of the liquid flowing to the point of use and on the other side to a spring (28) and a vacuum (line 50). The pressure regulator of Robinson '203 would appear to be of the general type that an artisan would recognize as being contemplated but not described in Robinson '241, and we agree with the examiner that one of ordinary skill in the art would

have found it obvious to install such a regulator in the structure of the primary reference.

We part company with the examiner, however, with regard to the double-walled tube modification. Robinson '241 appears to accomplish the same objective as the appellants' invention, that is, to supply liquid from the clean side to both the outlet to the point of use and, through the regulator, to the return line to the supply tank. This is done by placing the outlet line at one end of the central tube and the regulator and return line at the other end. While it is true that Wilkinson, Gebert and Burhans all disclose filters having a central double-walled tube with the contents of the annular outer passage flowing to one outlet and the contents of the inner passage flowing to another, it is not enough that a double-walled tube exists in the art, for the mere fact that the structure of Robinson '241 could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See ***In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the

filter of Robinson '241 by replacing the single central tube with a double walled tube. From our perspective, to do so would solve no problem and provide no improvement; it merely would be another way of accomplishing the same task. We can, however, perceive a disincentive to do so, in that such a modification would require a wholesale reconstruction of the Robinson '241 device.

Thus, it is our opinion that the only suggestion to combine the teachings of any of Wilkinson, Gebert and Burhans with those of the two Robinson patents is found in the hindsight accorded one who first viewed the appellants' disclosure. This, of course, is impermissible as a basis of a rejection under 35 U.S.C. § 103. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). In the final analysis, the teachings of the applied references fail to establish a *prima facie* case of obviousness with regard to the subject matter of claim 19. This being the case, we will not sustain the rejection of independent claim 19 or, it follows, of dependent claims 20, 21, 23 and 24.

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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